

PATENT

Paper No.

File: Contcir-P1-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : McDermott, Brian J.; McGowen, Daniel; Spotts, Ralph Leo Jr.; Tryzbiak, Sid

Serial No. : 10/790,363

Filed : March 1, 2004

For : ELECTRICAL DEVICE WITH TEETH JOINING LAYERS
AND METHOD FOR MAKING THE SAME

Group Art Unit : 2841

Examiner : Dinh, Tuan T

MS: No Fee Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FIRST PETITION TO THE DIRECTOR FOR RECONSIDERATION

S I R :

In the above-referenced patent application, Applicant respectfully requests reconsideration and reversal of the Examiner's decision in the Office Action mailed on June 12, 2007, to hold Applicant's Amendment and Response mailed on February 26, 2007, as not fully responsive; and further to require that consideration be given to the Declaration of Professor C. P. Wong.

In the Office Action mailed June 13, 2007, the Examiner states:

The reply filed on 03/02/07 is not fully responsive to the Office Action because of the following omission(s) or matter(s):

Applicant's responses are not persuasive because the Response and Remark filed on 03/02/07 that the applicant relies on the Declaration of Professor C.P. Wong with his "opinion" knowledge.

First, a declaration is not necessary for a complete response to an office action. Thus, the Amendment and Response filed on February 23, 2007, is not incomplete and not unresponsive for any reason due to the Declaration of Professor C. P. Wong.

Second, with regard to consideration of the Declaration of Professor C. P. Wong, *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) states: "Some weight out to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." Further, the declaration in its entirety is not mere "opinion" knowledge.

Third, Applicant wishes to clarify Professor C. P. Wong's statement that "I have been retained to give my opinion..." to make it clear that the statement refers to the fact that consulting rates were charged for Professor Wong's time in preparing the Declaration, but that Professor C. P. Wong has no vested interest in the outcome of this patent application.

In the Office Action mailed June 12, 2007, the Examiner also states:

However, Professor Wong is not in the inventor list.

Applicant is not entirely clear on the Examiner's statement and cannot determine, from the Examiner's comments, why the Amendment and Response would not be fully responsive in view of Professor Wong not being in the inventor list. Applicant respectfully believes that the Examiner's statement is completely irrelevant to completeness of an office action response.

In the June 12, 2007, Office Action, the Examiner further states:

Examiner asks for the written arguments or response from the applicants that the claims in the instant application in such different (sic) or overcome the reference cited by the examiner

Applicant's remarks appear in the filing of February 23, 2007, at pages 37-38.

Applicant respectfully respectfully submits that the filing of February 23, 2007, is complete and fully responsive. Applicant further requests that the Examiner's decision (that the February 23, 2007, Amendment and Response is not fully responsive) be reversed, and further that consideration be given to the Declaration of Professor Wong, as per *In re Lindell*.

If any extension of time is required, it is requested that this be deemed a petition and request therefore.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'PK Trzyna', followed by a horizontal line.

Date: July 12, 2007

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